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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,702	01/06/2000	JONATHAN VAN TASSEL	97-1804	2041

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EXAMINER

GRAY, JILL M

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/478,702

Applicant(s)

VAN TASSEL ET AL.

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 34-39, 59-68 and 97-108 is/are pending in the application.
- 4a) Of the above claim(s) 100-107 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-39, 59-68, 97-99 and 108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 100-107 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are drawn to a process of producing an electronic device, wherein said electronic device is drawn to a non-elected invention per Paper 11. Additionally, this method is separate and distinct from the originally presented process for producing a particulate tape.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 100-107 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Amendment***

The rejection of claims 1, 32-33, 35-36, 40-41, 70, 72, 74, and 78 under 35 U.S.C. 102(b) as being anticipated by European Patent Publication No. 475,592 is moot in view of applicants' amendment.

The rejection of claims 1, 18, 30, 32-33, 40-44, 46-51, 63, 69-70, 72-74, 77-83, 85-86, and 88-96 under 35 U.S.C. 102(b) as being anticipated by Jagannathan 4,865,703 is moot in view of applicants' amendment.

The rejection of claims 31 and 45 under 35 U.S.C. 103(a) as being unpatentable over Jagannathan is moot in view of applicants' amendment.

The rejection of claims 71, 75-76, 84, and 87 under 35 U.S.C. 103(a) as being unpatentable over Jagannathan in view of Grabbe 5,175,928 and "Electrophoretic Deposition - A Review" is moot in view of applicants' amendment.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34-35, 37-38, 59-61, 63, 68, 97-98, and 108 are rejected under 35 U.S.C. 102(b) as being anticipated by Jagannathan 4, 865,703, for reasons of record.

Jagannathan teaches a method and apparatus for producing a particulate magnetic recording media comprising an electrophoretic deposition bath having a nonconductive carrier with a conductive substrate mounted thereon, and electrophoretically depositing a particulate material onto said conductive area to form a component of said recording media, per claims 59, 63, 68, and 108. See column 7, line 40, through column 8, line 27. Jagannathan does not explicitly teach removing the recording media from the carrier and means associated therewith, nevertheless, this process step and means is implicit in his teachings of rinsing and oven drying the substrate. Accordingly, Jagannathan describes the claimed process steps and apparatus of "removing said component from said carrier", "removing said particulate tape from said carrier" and "means for removing said component from said carrier" within the meaning of 35 U.S.C. 102. Jagannathan discloses that the recording media

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is rinsed and oven dried, thus it is the examiner's position that Jagannathan fairly describes removal of the substrate and means associated therewith. It is of no moment that Jagannathan does not exemplify such process step and means, he provides a description of removing the recording media from the carrier just as surely as if the reference exemplified such process and means. See *In re Sivaramakrishnan*, 673 F.2d 1383, 1384-85, 213 USPQ 441, 442 (CCPA 1982). *In re Schaumann*, 572, F.2d 312, 316-17, 197 USPQ 5, 9 (CCPA 1978). The particulate material of Jagannathan is magnetic material and thereby is generally dielectric and conductive and is deposited in a substantially continuous form as required by claims 34-35 and 38. See column 2, lines 15-16. As to claims 37 and 60-61, Jagannathan teaches forming a pattern by alignment of the particles as well as providing for an area that does not require magnetic coating, further teaching that the first component can be formed at least partially on top of a second component. See column 6, lines 61-62 and column 8, lines 5-8. As to claims 97-98, Jagannathan teaches that his particulate material comprises binder that is dissolved into the bath. See column 7, lines 43-68.

Accordingly, the prior art teachings of Jagannathan anticipate the invention as claimed in present claims 34-35, 37-38, 59-61, 63, 68, 97-98, and 108.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62 and 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagannathan as applied above to claims 34-35, 37-38, 59-61, 63, 68, 97-98, and 108, for reasons of record.

Jagannathan is as applied above but does not specifically teach laminating the formed component to another surface or various carriers. As to laminating as required by claim 62, it would have been obvious to the skilled artisan to laminate the particulate recording media of Jagannathan in order to provide increased strength to the substrate or to provide labeling. Regarding the specific carriers as set forth in claims 64-67, the selection of the specific carrier is construed to be no more than a matter of obvious design choice commensurate with the desired end product.

Therefore, the prior art teachings of Jagannathan would have rendered obvious the invention as claimed in present claims 62 and 64-67.

Claims 36, 39 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagannathan as applied above to claims 34-35, 37-38, 59-68, 97-98, and 108, in view of Grabbe 5,175,928 and "Electrophoretic Deposition - A Review" (hereinafter Gani), for reasons of record.

Jagannathan is as set forth previously, but does not teach the specific particulate material of the present claims. Grabbe teaches electrophoretic deposition of dielectric material such as aluminum oxide and barium titanate and Gani teaches that various materials such as clays, alumina, silica, and metals can be electrophoretically deposited to form coatings. It would have been obvious to the skilled artisan at the time the invention was made, to use as the particulate material of Jagannathan any materials

known in the art capable of electrophoretic deposition and acting as a dielectric or conductor, such as those particulates taught by Grabbe and Gani, motivated by the reasonable expectation of a known particle functioning in its known manner, namely, as a dielectric. Regarding claim 99, it would have been obvious to spray additional binder onto the recording media of Jagannathan before drying to enhance bonding of the particulate material to the substrate.

Therefore, when considered as a whole, the combined teachings of Jagannathan, Grabbe, and Gani would have rendered obvious the invention as claimed in the present claims.

### ***Response to Arguments***

Applicant's arguments filed February 9, 2004 have been fully considered but they are not persuasive.

Applicants argue that there is no teaching or suggestion in Jagannathan of removing the electrophoretically deposited "coating" from the carrier to create a carrier independent particulate tape, further arguing that Jagannathan has no specific mention of the deposited coating being "removable" from the carrier.

In this regard, Jagannathan teaches that the conductive substrate is mounted on a non-conductive carrier, electrophoretically coated and recovered in the formation of recording media. Accordingly, Jagannathan teaches removing the deposited "coating" from the carrier. Applicants' claims do not exclude additional components, and the language of "carrier" is nonspecific and would describe the non-conductive carrier of

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Jagannathan. In addition, the carrier having an electrically conductive are on at least one surface would describe the conductive substrate mounted thereon of Jagannathan.

Applicants argue that other claimed features are not found in Jagannathan or the prior art, such as the use of a patterned electrode or multiple patterned electrodes.

In this regard, as set forth previously, Jagannathan teaches alignment of the particles along the electrode as well as providing an area on the conductive substrate that does not require magnetic coating and that the first component can be formed at least partially on top of a second component.

Therefore, when considered as a whole, the prior art teachings would have rendered obvious the invention as claimed in the present claims.

No claims are allowed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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